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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,175	11/01/2001	Peter H. Seeberger	MTV-018.02	7902

25181 7590 03/06/2003

FOLEY HOAG, LLP
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EXAMINER

KHARE, DEVESH

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/06/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,175

Applicant(s)

SEEBERGER ET AL.

Examiner

Devesh Khare

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 42-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____.

DETAILED ACTION

Election of Species

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits.

Applicant is advised that a complete reply to this requirement must include an identification of the species that is elected and a listing of all claims readable thereon. Applicant is entitled to consideration of claims to a reasonable number of disclosed species in addition to the elected species provided all the claims to each additional species are written in dependent form or otherwise include all the limitation of an allowed generic claim as provided by 37 CFR 1.141. Applicant's reply must include an identification of such additional species along with a listing of the claims readable on each additional species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the invention.

A telephone call was made to Dana Gordon on 2/25/03 to request an oral election of species. Applicant has elected the definition of variable X to O, Y to O and Z to O in claims 1-23 and 42-44.

Claims 5,7,9,11,13,15,20 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Claims 1-4,6,8,10,12,14,16-19,21,23 and 42-44 are currently pending in this application.

An action on the merits of claims 1-4,6,8,10,12,14,16-19,21,23 and 42-44 is contained herein below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6,8,10,12,14,16-19,21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabesan(U.S. Patent 5,095,123) or Hashimoto et al.(J. Chem. Soc. Chem. Commun. pp. 685-687, 1989).

The applicants' claims are directed toward phosphate-based glycosyl donors oligosaccharides.

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Sabesan discloses the glycosyl phosphate triesters (see abstract and claims). In col.3, lines 42-65, the glycosyl phosphate triesters of formula I and II are disclosed. The compounds represented by the structure 1 of the present claim 1 are anticipated by the disclosure in col. 5, Reaction scheme 1, wherein compounds obtained from the phosphorylation of hexopyranose compounds are disclosed, see especially the compounds disclosed in col. 9, examples 2,3 and 5.

Hashimoto et al. discloses the compounds represented by the structure 1 of the present claim 1 and benzyl protected glycopyranosyl and galactopyranosyl diphenyl phosphates of the present claim 23, see page 686, structures 1-5, which are encompassed by the applicants claims.

Provisional "Non-Statutory" Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No.6,323,339 of the applicants. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the present claims are directed towards a method of synthesizing a compound represented by 1 in claim 42 where variables X is O, NR', or S, Y is O, NR' or S and Z is O, NR' or S (applicant has elected the definition of variable X to O, Y to O and Z to O in the election of species requirement), and overlap the invention cited in claims 17-19 of '339, which are directed toward a method of synthesizing a compound represented by 1 in claim 17 where variables X is O, NR', or S, Y is NR' or S and Z is O, NR' or S. However, claims 42-44 where variable Y represents O are free of the prior art.

The issued patent '339 differ from the present application in that it does not claim a compound represented by 1 where variable Y is O.

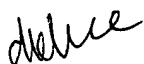
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the


Examiner should be directed to Devesh Khare whose telephone number is (703)605-

1199. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 703-308-4624. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Devesh Khare, Ph.D.,JD(3Y).
Art Unit 1623
February 27,2003



SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1600